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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/707,270	11/06/2000	Birgit Schleifenbaum	Mo-5666/HR-231	8303

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09/16/2004

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EXAMINER

TRAN LIEN, THUY

ART UNIT

PAPER NUMBER

1761

DATE MAILED: 09/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/707,270

Applicant(s)

SCHLEIFENBAUM ET AL.

Examiner

Lien T Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 August 2004.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☒ Claim(s) 1-4 is/are allowed.  
6) ☒ Claim(s) 5-12 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

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Claim 12 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In the amendment filed 4/3/03, applicant added new claim 12 which recites " a process as in claim 5, wherein said particles comprise less than 1 ppm isopropanol". The limitation in this claim is not support by the original claim and the specification; there is no disclosure in the specification of particle comprising less than 1ppm isopropanol.

Claim 12 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 12 is vague and indefinite. Claim 12 is a process claim; however, it depends on claim 5 which is a product claim. It is not clear what is intended.

Claims 5-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Porzio in view of Fulger et al.

Porzio discloses encapsulation compositions and process for preparing them. The process comprises the steps of forming a carbohydrate matrix by heating the carbohydrates in an extruder at a temperature in the range 194 to 320 degree F to form a melted matrix and then mixing an active agent into the melted matrix. The final extruded composition may be used as extruded in the form of an extruded rod or

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filament. Alternatively, the extruded material may be further processed after cooling by grinding, pulverizing. The encapsulate includes agents such as medications, flavoring agents, food colorant etc.. The encapsulation compositions have a Tg of at least 35 degree C. (See the examples)

Porzio does not disclose particles treated with an inert gas and the size of the particles as claimed.

Fulger et al disclose a process for flavor encapsulation in a carbohydrate matrix. They teach the particles can be cooled by number of ways such as ambient air cooled on tray, atmospheric pressure cylindrical collection in ice bath, cooled in cold 99% isopropanol and pressure cooking. (See the examples)

It would have been obvious to one skilled in the art to use any known method in the art to cool the extruded composition of Porzio. Cooling using air is known as shown by Fulger et al. The velocity at which the air is delivered is a difference in the way that the product is made; determination of patentability in product-by-process claimed is based on the product itself not on how it is made. As to the size, it would have been obvious to make the particles in any size desired depending upon its intended use.

In the request for RCE filed 8/9/04, applicant submits a declaration to show unexpected result in the claimed product; the declaration is not found to be persuasive. The declaration states the particles of claims 5-11 have three superior properties of "lack of exposed flavoring on the surface, superior storage stability and absence of isopropanol. This showing is not commensurate in scope with the claims because the claims do not recite any of these properties; thus, it is not an issue to be considered in

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the prior art rejection. On page 5 of the declaration, it is stated that particles cooled down with ambient air as taught by Fulger still have a significant amount of flavoring on the surface. The declaration does not state what this significant amount is. Also, the claims do not have limitation of the amount of flavoring on the particles; thus, it is not a limitation that needs to be considered in applying the rejection. Page 6 gives a comparative showing of the isopropanol content of claims 5-11 and the prior art. Page 6 states the particles cooled down by cold 99% isopropanol contain up to 700 ppm of isopropanol and the amount remains within the range of 100-150 ppm after drying and storage. This showing is not germane to the rejection because there is no limitation on the amount of isopropanol in claims 5-11. Furthermore, Fulger et al teach other method of cooling. When other methods are used, there will not be any isopropanol on the particles.

Claims 1-4 and 12 are allowable <sup>over the prior art</sup> for reason of record.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lien T Tran whose telephone number is 571-272-1408. The examiner can normally be reached on Tuesday, Wednesday and Friday.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

September 15, 2004

  
LIEN TRAN  
PRIMARY EXAMINER  
Group 1700